

ALLOWANCE

This action is in response to Applicant's submission dated June 25, 2008 in which Applicant cancelled claims 20-26 and added new claim 32. Claims 1-17 and 28, and 30-32 are allowed.

Specification

Examiner acknowledges Applicant's correction of the title as requested.

Claim Rejections - 35 USC § 112

Examiner had previously rejected claims 1-17, 20-26 and 28 under 35 U.S.C. 112, first paragraph, because the specification does not reasonably provide enablement for making prodrugs or solvates of the claimed compounds. This rejection is now moot based on Applicant's cancellation of claims 20-26.

Examiner had previously rejected claim 11 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement because the specification does not enable the instant compounds to treat a disease condition mediated by collagenase 3, an obstructive airways disease, osteoarthritis, atherosclerosis, a metalloproteinase mediated disease condition or rheumatoid arthritis with a therapeutically-effective amount of a compound of claim 1 or enable one skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention.

Applicant is correct that Examiner intended to apply this rejection to claims 20-26 as opposed to claim 11. This rejection is now moot based on Applicant's cancellation of claims 20-26.

Examiner had previously rejected claims 1, 9 and 28 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

- (a) This rejection is now moot based on Applicant's amendment of claim 1.
- (b) This rejection is now moot based on Applicant's amendment of claim 9.
- (c) This rejection is now moot based on Applicant's argument and amendment of claim 28.
- (d) This rejection is now moot based on Applicant's argument and amendment of claim 28.
- (e) This rejection is now moot based on Applicant's argument and amendment of claim 28.

Claim Rejections 35 U.S.C. § 103

Examiner had previously rejected claims 1-3, 8-11, 14, 16-17 and 23-26 under 35 U.S.C. § 103(a) as being unpatentable over Barlaam, et al., U.S. Patent No. 6,734,184. Examiner misapplied this reference and such withdraws this rejection.

Examiner's Amendment

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to Applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

In a telephone discussion dated September 16, 2008, Applicant gave Examiner authorization for this Examiner's Amendment.

The Application has been amended as follows:

Claim 29: CANCELLED.

Art Unit: 1624

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Erich A. Leeser whose telephone number is 571-272-9932. The Examiner can normally be reached Monday through Friday from 8:30 to 6:00 EST.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax number for the organization where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197. If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/James O. Wilson/

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